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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/008,947	01/20/1998	RANDELL L. MILLS	911322US	6830

7590 07/18/2005

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EXAMINER

KALAFUT, STEPHEN J

ART UNIT	PAPER NUMBER
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1745

DATE MAILED: 07/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/008,947

Applicant(s)

MILLS, RANDELL L.

Examiner

Stephen J. Kalafut

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-6 and 10-59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-6 and 10-59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 13 May 2005
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 13 May 2005 has been entered.

Claims 1-2, 4-6 and 10-59, for reasons of record, are rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility. See paper no. 17, paragraph no. 3.

Claims 1-2, 4-6 and 10-59, for reasons of record, are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. See paper no. 17, paragraph no. 4.

Applicant's arguments filed 13 May 2005 have been fully considered but they are not persuasive.

Applicant's arguments of 13 May 2005 repeat many of the same points as his arguments previously submitted 7 January 2004, such as prosecution history and comments made by various examiners during an interview. A few specific points are herein addressed.

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Applicant argues (page 20 of his "Remarks") that the "Secret Committee" has nitpicked on "theoretical grounds", and has not found fault on any "legitimate scientific grounds". This argument appears to wrongly assume that "theoretical" and "scientific" grounds are somehow mutually separate. Instead, since theory is part of science, a "theoretical" reason is a type of "scientific reason". Moreover, the Appendices enclosed with some of the previous actions, and the attached Appendix, have dealt with applicant's experimental data as well as his theory. For example, see the Appendix attached to the Office Action, paper 20040405, pages 2 through 5, for some comments concerning applicant's alleged evidence.

Applicant argues (page 20) that the "Committee" has failed to identify "even a single physical law" which has been violated. In paper no. 40, referring to the Krieg reference, the Office has shown that applicant's theory violates the physical law concerning the ground state of an electron of a hydrogen atom. On page 3 of his article (actually a webpage), Krieg uses an energy balance (potential + kinetic = total), the basic laws of electricity and magnetism, the uncertainty principle, and ordinary calculus to prove that the minimum energy level is the normally accepted "ground state".

Applicant argues (page 109) that examiner Bernard Souw owns a company which provides consulting services in two technical areas, microwave plasma devices and CVD diamond synthesis. While an examiner with such outside employment may appear to have a conflict of interest, such a conflict can be avoided if he refrains from either working on applications dealing with these, or working on these things in his outside employment. The present application, however, is drawn to a fuel cell, which is outside those fields, and thus would not be in competition with any consultation therein.

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Regarding the IDS of 13 May 2005, attachments 58, 60, 77, 80, 88, 94, 96, 97, 98 and 102-107 have already been made of record, and were addressed in either paper no. 20040405 or paper no. 20041114.

Referring to the categories set out in paper no. 20040405:

Attachments 108, 109, 111 and 112 would fall into category (1), because they have not been peer-reviewed.

Attachments 108, 110 and 112 would fall into category (3) because they contain data that cannot be accounted for by applicant's theory, as explained in paper no. 40, pages 4 and 5.

Attachments 108, 109, 111 and 112 would fall into category (4) because they speculate hydrino formation as an explanation for data not necessarily caused thereby.

Attachments 111 and 112 were submitted, but not listed on the accompanying PTO-1449.

Please also see the attached Appendix.

This is an RCE of applicant's earlier Application No. 009/008,947. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen J. Kalafut whose telephone number is 571-272-1286. The examiner can normally be reached on Mon-Fri 8:00 am-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick J. Ryan can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

sjk



STEPHEN J. KALAFUT
PRIMARY EXAMINER
GROUP

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